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**To:** The Chamber of Commerce of the United St ETC.  
([tmdocketdc@kenyon.com](mailto:tmdocketdc@kenyon.com))

**Subject:** U.S. TRADEMARK APPLICATION NO. 77147075 - NATIONAL  
CHAMBER - 11904-185

**Sent:** 8/12/2009 6:53:41 PM

**Sent As:** ECOM102@USPTO.GOV

**Attachments:**

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**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 77/147075

**MARK:** NATIONAL CHAMBER

**CORRESPONDENT ADDRESS:**

WILLIAM M. MERONE  
KENYON & KENYON LLP  
1500 K ST NW STE 700  
WASHINGTON, DC 20005-1257

**RESPOND TO THIS ACTION:**

<http://www.uspto.gov/teas/eTEASpageD.htm>

**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/main/trademarks.htm>

**APPLICANT:** The Chamber of Commerce  
of the United St ETC.

**CORRESPONDENT'S  
REFERENCE/DOCKET NO:**

11904-185

**CORRESPONDENT E-MAIL ADDRESS:**

[tmdocketdc@kenyon.com](mailto:tmdocketdc@kenyon.com)

**OFFICE ACTION**

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

**ISSUE/MAILING DATE: 8/12/2009**

**THIS IS A FINAL ACTION.**

Applicant's response filed August 7, 2009, is acknowledged by this FINAL office action. Applicant did not provide a direct answer to the information requirement. Further, the amendment to the identification of services identifies multiple classes of services and it is therefore unacceptable. Lastly, the mark is descriptive of the services recited in the response.

**Refusal - Section 2(e)(1) - Final**

The examining attorney refused registration on the Principal Register because the proposed mark merely describes the services. Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1); TMEP §1209 et seq. Applicant questioned the basis for the refusal. In response to applicant calling into question the grounds for the refusal, the examining attorney posed an unambiguous question to applicant about a feature of the services. Applicant failed to answer this question. If applicant appeals this refusal, the Trademark Trial and Appeal Board will certainly consider applicant's evasiveness in determining the appeal. Moreover, the failure to answer the inquiry provides additional ground for refusing the mark.

Again, a mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. 1052(e)(1), if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986).

The examining attorney must consider whether a mark is merely descriptive in relation to the identified services, not in the abstract. *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). Applicant's proposed mark is NATIONAL CHAMBER for "providing online directory information services featuring information regarding local and state Chambers of Commerce; providing information and news in the field of business, namely information and news on current events and on economic, legislative, and regulatory developments that can impact businesses; administration of a discount program enabling participants to obtain discounts on goods and services." As used therewith, the proposed mark immediately imparts information about an important feature, function or purpose of the identified services.

Applicant has disclaimed the term CHAMBER that appears in the identification of services. Further, the term "national" is merely descriptive of services that are nationwide in scope. TMEP §1209.03(o); see, e.g., *In re Nat'l Rent A Fence, Inc.*, 220 USPQ 479 (TTAB 1983) (holding NATIONAL RENT A FENCE merely descriptive of nationwide fence rental services); *Nat'l Fid. Life Ins. v. Nat'l Ins. Trust*, 199 USPQ 691 (TTAB 1978) (holding NATIONAL INSURANCE TRUST merely descriptive of services of handling administrative matters in locating suitable insurance coverage for attorneys). Consequently, the refusal is made FINAL.

### Identification of Services – Final

The examining attorney may require an amendment of the identification language to accurately describe the services. *In re Water Gremlin Co.*, 635 F.2d 841, 208 USPQ 89 (C.C.P.A. 1980), *aff'd* 204 USPQ 261 (TTAB 1979). Applicant must amend certain wording as indicated below. See TMEP §1402.01.

"providing online directory information services featuring information regarding local and state Chambers of Commerce; providing information and news in the field of business, namely[,] information and news on current events ["information and news on current events" are class 41 services] and on economic, legislative [term "legislative" is too ambiguous -- information on legislation is a class 45 service], and regulatory developments ["regulatory developments" is subject matter classified in class 45 regardless of the end application] that can impact businesses; administration of a discount program enabling participants to obtain discounts on goods and services" in International Class 35.

Identifications of services can be amended only to clarify or limit the services; adding to or broadening the scope of the services is not permitted. 37 C.F.R. §2.71(a); see TMEP §§1402.06 et seq., 1402.07. Therefore, applicant may not amend the identification to include services that are not within the scope of

the services set forth in the present identification.

If applicant prosecutes this application as a combined, or multiple-class application, then applicant must comply with each of the following for those goods and/or services based on an intent to use the mark in commerce under Trademark Act Section 1(b):

- (1) Applicant must list the services by international class; and
- (2) Applicant must submit a filing fee for each international class of services not covered by the fee already paid (current fee information should be confirmed at <http://www.uspto.gov>).

See 15 U.S.C. §§1051(b), 1112, 1126(e); 37 C.F.R. §§2.34(a)(2)-(3), 2.86(a); TMEP §§1403.01, 1403.02(c).

#### **Information Requirement -- Final**

Applicant was required to answer the inquiry raised in the previous office action. Because applicant did not comply with a requirement for information, registration is refused. See 37 C.F.R. §2.61(b). Applicant should answer the inquiry with a "yes" or "no" answer.

Will applicant use the proposed mark in connection with a national directory of chambers of commerce?

The validity of a trademark registration is based upon applicant's material representations of fact in connection with their application. See *Torres v. Cantine Torresella S. r. l.*, 808 F.2d 46, 1 USPQ2d 1483, 1484 (Fed. Cir. 1986).

#### **Applicant's Options**

If applicant does not respond within six months of the mailing date of this final Office action, the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond to this final Office action by:

- (1) Submitting a response that fully satisfies all outstanding requirements, if feasible; and/or
- (2) Filing an appeal to the Trademark Trial and Appeal Board, with an appeal fee of \$100 per class.

37 C.F.R. §§2.6(a)(18), 2.64(a); TBMP ch. 1200; TMEP §714.04.

In certain rare circumstances, a petition to the Director may be filed pursuant to 37 C.F.R. §2.63(b)(2) to review a final Office action that is limited to procedural issues. 37 C.F.R. §2.64(a); TMEP §714.04; see 37 C.F.R. §2.146(b); TBMP §1201.05; TMEP §1704 (explaining petitionable matters). The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

Christopher L. Buongiorno

/Christopher L. Buongiorno/  
Law Office 102  
(571) 272-9251

**RESPOND TO THIS ACTION:** Applicant should file a response to this Office action online using the form at <http://www.uspto.gov/teas/eTEASpageD.htm>, waiting 48-72 hours if applicant received notification of the Office action via e-mail. For *technical* assistance with the form, please e-mail [TEAS@uspto.gov](mailto:TEAS@uspto.gov). For questions about the Office action itself, please contact the assigned examining attorney. **Do not respond to this Office action by e-mail; the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

**STATUS CHECK:** Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

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### **IMPORTANT NOTICE REGARDING YOUR TRADEMARK APPLICATION**

Your trademark application (Serial No. 77147075) has been reviewed. The examining attorney assigned by the United States Patent and Trademark Office ("USPTO") has written a letter (an "Office action") on 8/12/2009 to which you must respond (*unless the Office letter specifically states that no response is required*). Please follow these steps:

1. Read the Office letter by clicking on this link [http://tmpportal.uspto.gov/external/portal/tow?DDA=Y&serial\\_number=77147075&doc\\_type=OOA&mail\\_date=20090812](http://tmpportal.uspto.gov/external/portal/tow?DDA=Y&serial_number=77147075&doc_type=OOA&mail_date=20090812) OR go to <http://tmpportal.uspto.gov/external/portal/tow> and enter your serial number to access the Office letter. If you have difficulty accessing the Office letter, contact [TDR@uspto.gov](mailto:TDR@uspto.gov).

**PLEASE NOTE:** The Office letter may not be immediately available but will be viewable within 24 hours of this e-mail notification.

2. **Contact** the examining attorney who reviewed your application if you have any questions about the content of the Office letter (contact information appears at the end thereof).

3. **Respond** within 6 months, calculated from **8/12/2009** (*or sooner if specified in the Office letter*), using the Trademark Electronic Application System (TEAS) **Response to Office Action form**. If you have difficulty using TEAS, contact [TEAS@uspto.gov](mailto:TEAS@uspto.gov).

#### **ALERT:**

**Failure to file any required response by the applicable deadline will result in the ABANDONMENT (loss) of your application.**

**Do NOT hit "Reply" to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses.**